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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/994,960

11/27/2001

Koji Tokunaga

15124

1702

23389

7590

05/04/2006

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EXAMINER

PHUONG, DAI

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/994,960

Applicant(s)

TOKUNAGA, KOJI

Examiner

Dai A. Phuong

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's arguments, filed 02/28/2006, with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Claims 1-3 are currently pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei et al. (U.S. 5732349) in view of Minakata et al. (U.S. 6658496).

Regarding claim 1, Sanpei et al. disclose a portable phone having a recording function for recording audio data during telephone conversation (fig. 3, col. 5, lines 1-14), said portable phone comprising: a memory 24 which is for endless recording, as a conversation content, the audio data during the telephone conversation (fig. 3, col. 5, lines 1-14). However, Sanpei et al. do not disclose a plurality of memories, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation; a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio data instead of said first memory which endless-records, as the conversation content, the audio data until said switching unit switches said memories from said first memory to said second memory; and a reproducing unit for

reproducing the conversation content which said first memory endless-records before being switched by said switching unit, while the second memory endless-records the current conversation.

In the same field of endeavor, Minakata et al. disclose a plurality of memories 9a and 9b, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation (fig. 1, col. 2 lines 53-67); a switching unit 50 capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio data instead of said first memory which endless-records, as the conversation content, the audio data until said switching unit switches said memories from said first memory to said second memory (col. 3, lines 32-51); and a reproducing unit 20 for reproducing the conversation content which said first memory endless-records before being switched by said switching unit, while the second memory endless-records the current conversation (fig. 1, col. 4, line 47 to col. 5, line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephone of Sanpei et al. by specifically including a plurality of memories, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation; a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio data instead of said first memory which endless-records, as the conversation content, the audio data until said switching unit switches said memories from said first memory to said second memory; and a reproducing unit for reproducing the conversation content which said first memory endless-records before being switched by said

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switching unit, while the second memory endlessly-records the current conversation., as taught by Minakata et al., the motivation being in order to provide a recording/reproducing apparatus in which it is possible to improve tractability of a recording/reproducing apparatus having plural storage units, such as removable storage units, and to facilitate the operation of transfer processing for data stored in a storage unit of the recording/reproducing apparatus.

Regarding claim 2, the combination of Sanpei et al. and Minakata et al. disclose all the limitations in claim 1. Further, Minakata et al. disclose a portable phone wherein said memories are constituted by a plurality of memory areas of a single memory device, said memory areas being capable of individually endlessly-recording the audio data (col. 5, lines 64 to col. 6, line 12).

Regarding claim 3, the combination of Sanpei et al. and Minakata et al. disclose all the limitations in claim 1. Further, Minakata et al. disclose a portable phone further comprising a key for operating said reproducing unit to reproduce the audio data; said reproducing unit successively reproducing the conversation contents in the order of recording in which said memories records the conversation contents (fig. 1, col. 4, line 47 to col. 5, line 11).

### *Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ramos Feliciano Eliseo can be reached on 571-272-7925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong  
AU: 2617  
Date: 04-27-2006

  
ELISEO RAMOS-FELICIANO  
PRIMARY EXAMINER